

REMARKS IN SUPPORT OF THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW

To: Commissioner for Patents

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Application: 10/649,419
Attorney docket: ADPS.0001
TITLE: METHOD FOR INTEGRATING DRAWINGS
AND SUPPORTING DOCUMENTS USING
GRAPHIC OBJECT INTERFACE

Inventor: David Weidner
Filing date: August 26, 2003
Art Unit: 2179
Examiner: Nicholas Augustine

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REMARKS IN SUPPORT OF THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Final Office Action mailed June 20, 2007 (hereinafter, “the Final Office Action”) and further pursuant to the Notice of Appeal and Pre-Appeal Brief Request for Review submitted herewith, the Applicants respectfully request review and reconsideration of the Final Office Action in view of the following issues.

Pursuant to MPEP 2163.06 that states “If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.” In this case, the Examiner has asserted new matter in the specification, the Examiner objected to the asserted new matter and the Examiner has asserted rejections. Thus this patent application is ripe for appeal.

1. The objection to new matter in the specification under 35 U.S.C. 132(a) does not recognize that the added material is supported by the original disclosure.

The final Office Action dated June 20, 2007 states that:

“The added material which is not supported by the original disclosure is as follows:... Pages 2-17 of the specification, figures 4, 7, 8 and 10-14, and claims 1-9. Examiner believes the added material to the specification, drawings and claims constitutes as new matter to the case. Applicant states that replacement

of new specification to remedy the objects made by the Examiner under 112 1st and 2nd paragraph for claims 1-9 (page 6 of remarks). Applicant states added drawings are for support of amended claims 1-9 which originally claimed to features not shown in the figures (page 5 and 8 of remarks). Applicant states that no new matter is entered, wherein the Examiner disagrees and believes the amended specification covers ideas, principles and detailed facts which were not originally disclosed with the original discloser, also noted that the amended claims now direct themselves to rely on the new specification rendering them to be new matter. Applicant is required to cancel the new matter in the reply to this Office Action.

Matter added from another part of the application

MPEP 2163.06 states “Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.”

The following discussion of the paragraphs of the amended specification shows that the added text of the amended specification is taken from another “part of the application” that was filed on August 2, 2003 “without introducing new matter” as MPEP requires.

In regards to the matter in paragraph 10, the original source is page 1 lines 17-19 of the specification filed on August 2, 2003, which is permissible under MPEP 2163.06.

In regards to the matter in paragraph 11, the original source is page 2 lines 9-12 of the specification filed on August 2, 2003, which is permissible under MPEP 2163.06.

In regards to the matter in paragraph 28, the original source is FIG. 1. The text of paragraph 28 is merely a written observation of what is visually depicted in FIG. 1 of the drawings filed on August 2, 2003.

In regards to the matter in paragraph 30, the original source is claim 2 on page 6 and claim 5 on page 7.

In regards to the matter in paragraph 32, the original source is FIG. 1 of the specification filed on August 2, 2003.

In regards to the matter in paragraph 33, the original source is FIG. 2 of the specification filed on August 2, 2003.

In regards to the matter in paragraph 34, the original source is claim 3 on page 6.

In regards to the matter in paragraph 35, the original source is claim 4 on pages 6-7, claim 6 on page 7, claim 7 on page 7, and claim 8 on page 7.

In regards to the matter in paragraph 36, the original source is page 2 lines 3-5 of the specification filed on August 2, 2003.

In regards to the matter in paragraph 45, the original source is claim 1 on page 6 and claim 9 on page 7.

In regards to the above citation of claims from the original filed application that were used to amend the specification, this practice is approved by MPEP 2163.06(III) "if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include

the claimed subject matter. In re Benno, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).”

Well Known In the Art

The drawing of a standard computer in FIG. 10 and a written description of that standard computer in paragraphs 46-56 are not new matter, but are well known prior art. In fact, FIG. 10 is labeled “PRIOR ART.” The inclusion of this matter in the application was not necessary, but nonetheless a conventional approach to the organization of a computer-enabled invention. Adding well-know prior to a

Obvious Errors

MPEP2163.07(II) states “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.”

The following discussion of the paragraphs of the amended specification shows that added text of the amended specification is a correction of an obvious error of the specification that was filed on August 2, 2003 “without introducing new matter” as MPEP requires.

Paragraphs 12-21 of the amended specification is includes amendments that are corrections of errors, the errors including capitalization of letters in the middle of sentences, multiple sentences for the description of a singular drawing, use of periods in between descriptions of drawings. The original erroneous source having obvious

errors is page 2 lines 14 – page 3 line 13 of the specification filed on August 2, 2003.

Inherent Function, Theory, or Advantage

MPEP 2163.07(a) states “By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.”

The following discussion of the paragraphs of the amended specification shows that added text of the amended specification is inherent in the specification that was filed on August 2, 2003 “without introducing new matter” as MPEP requires.

In regards to the matter in paragraph ?, the original source is page ? lines ? of the specification filed on August 2, 2003.

Claims 10-18

In response to the objection in the Office Action dated Dec. 11, 2006 that the drawings do not show “each and every feature of the invention specified in the claims” under 37 CFR 1.83(a), in the Amendment dated Feb. 12, 2007, drawing sheets 10-14 were added.

Yet, in the final Office Action dated June 6, the Examiner asserts “original disclosure does not cover the amended claims 1-9” (paragraph

5) and “that the amended claims now direct themselves to rely on the new specification rendering them to be new matter” (paragraph 2) as evidence, if not conclusive evidence, that the claims contain new matter.

In order to illustrate the source in the Application filed on August 26, 2003 of the claims 10-18, Applicant provides an annotated version of claims 10-18 below that includes explicit cites to the Application filed on August 26, 2003 to show that the matter of claims 10-18 was disclosed in the application filed on August 26, 2003. In some instances, slight rephrasing/rewording is made in the language from the cited source in order to correct obvious errors in accordance with MPEP 2163.07(II) which states that “[a]n amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction” and MPEP 2163.07(I) which states that “[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).”

10. A computer-accessible medium comprising at least one menu (page 5 lines 10-11) embedded into computer based project representations (page 6 lines -10), the at least one menu (page 5 lines 10-11) being operable to display construction (page 3 lines 19-20) project information (page 6 line 3) on a computer display (page 6 line 3) to users (page 8 line 13), which facilitates construction, repair or maintenance of at least one construction project item (page 6 lines 10-11) represented within a drawing (page 6 line 11) and

connected through a graphical object interface that represents an integration of more than one relational link (page 6 lines 11-12).

11. The computer-accessible medium of claim 10, wherein the computer based project representations (page 6 lines 9-10) of the relational links (page 6 lines 12) represented by visual attributes (page 6 line 14), visual attributes being represented by any color, number or other informational symbol (page 6 lines 14-15).

12. The computer-accessible medium of claim 10, wherein the computer based project representations (page 6 lines 9-10) further comprises a computer based project representation represented using a licensed and proprietary computer based platform (page 6 lines 16-17) in at least 2 dimensions, including at least one 2 dimensional graphic object interface format with a 2 dimensional link within a 3 dimensional drawing and a 3 dimensional link embedded into a 2 dimensional drawing (page 6 lines 17-20).

13. The computer-accessible medium of claim 10, wherein the graphic object interface directly links a variety of information items including menus, programs, databases, Internet links, video, any other multimedia files with other project related links to other informational items in a relational manner (page 6 line 21 – page 7 line 2).

14. The computer-accessible medium of claim 10, wherein the graphical object interface is combined with at least one of a portable media that provides a facility to troubleshoot problems within the graphical object interface without a printed manual or other associated support material (page 7 lines 3-6).

15. The computer-accessible medium of claim 10,

wherein the at least one menu (page 5 lines 10-11) further comprises a database incorporated into the menu that provides for automated maintenance to be performed by an owner of property and alternately when connected to a network, is operable to be printed from anywhere in the menus to include all pertinent information for equipment to be maintained (page 7 lines 7-10).

16. The computer-accessible medium of claim 10, wherein each construction project item (page 6 lines 10-11) in the graphic object interface further comprises a project management module having a menu system that is independently operable (page 7 lines 11-12).

17. The computer-accessible medium of claim 10, wherein the at least one menu (page 5 lines 10-11) is operable to be performed by an individual computer system (page 7 lines 13-15).

18. A computer-accessible medium comprising a computer program embedded into computer based project representations (page 6 lines 9-10), the computer program being operable to display construction project information on a computer display (page 6 line 3) to users, which facilitates the construction, repair or maintenance of one or more construction industry project items (page 6 lines 10-11) represented within a drawing (page 6 line 11) and connected through a graphical object interface (page 6 lines 11-12) that represents an integration of more than one relational links (page 6 lines 12), the medium further comprising URL's operable to link to the Internet to perform remote operations or run updates for the computer program, equipment maintenance or other databases (page 7 lines 16-19).

2. The rejection of claim 10-18 under 35 U.S.C. 132(a) does not recognize that the added material is supported by the original disclosure.

The final Office Action dated June 20, 2007 states that:

Claims 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is predicated upon the assertion that claims 10-18 contain new matter. As discussed above, the application contains no new matter. Therefore, Applicant requests that the Office withdraw the 35 USC 112 rejection.

3. The rejection of claims 10-18 under 35 U.S.C. 102(b) are missing at least one element for each claim.

The final Office Action dated June 20, 2007 rejected claims 10-18 under 35 U.S.C. 102(b) as being anticipated by Microsoft (Internet Explorer Version 6.0.2800.1 1 06.xpspl.020828-1920CO).

Claims 10 and 18. Independent claims 10 and 18 require a “construction industry project item” and “construction, repair or maintenance of at least one construction project item.” “Construction

industry” is not disclosed in the reference of Microsoft Internet Explorer, therefore, claims 10 and 18 are novel over the Microsoft Internet Explorer reference. Moreover, Microsoft Internet Explorer is a “horizontal” application in which the application does not have an implementation to any particular specific vertical industry, such as “construction.” Accordingly, Microsoft Internet Explorer would not be configured, designed or modified to accommodate in any particular manner “construction industry.”

Claim 12. claim 12 requires “a computer based project representation represented using a licensed and proprietary computer based platform.” However, the Microsoft Internet Explorer reference does not disclose any such “licensed and proprietary computer based platform.”

Thus the cited reference fails to disclose or suggest at least two elements of claims 10 and 18. Therefore claims 10 and 18 are allowable over the cited reference. Claims 11-17 depend directly or indirectly from claim 10, and are therefore allowable at least by virtue of their dependence from allowable claim 10. Thus, applicant respectfully requests withdrawal of the 35 USC 102(b) rejection.

CONCLUSION

Applicants have pointed out specific features of the claims that are not new matter and not disclosed, suggested or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the objections and rejections, as well as an indication of allowability of each

of the claims now pending.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Michael G. Smith", written in a cursive style.

Dated: September 22, 2007

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